

**REMARKS**

1. In the Office Action mailed 9/08/04, claim 73 was objected to because of a typographical error. The typographical error has been corrected herein. The specification was objected to because of two typographical and/or editorial errors. The errors in the specification have been corrected herein.

2. Claims 1, 4-12, 23, 26-34, 45, 48-56, 67, and 70-83 were rejected under 35 USC 102(e) as being anticipated by Lund (U.S. Patent 6,658,100). Applicant respectfully traverses this rejection, and asserts that Lund does not disclose all of the limitations of claim 1, which are incorporated into claims 4-12 which depend from claim 1, mirrored in claim 23 and thus incorporated into dependent claims 26-34, mirrored in claim 45 and thus incorporated into dependent claims 48-56, mirrored in claim 67 and thus incorporated into dependent claims 70-83.

3. Directing Examiner's attention to MPEP 2131, the threshold issue under Section 102 is whether the Examiner has established a *prima facie* case for anticipation. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)". "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989). The elements must be arranged as required by the claim but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

4. To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). **Missing elements** may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

5. Claim 1 of the present application reads:

A method for providing an improved interface to a caller during the initiation of a VoIP call comprising:

placing, by the caller, a request for information regarding a party to be called;

returning a URL responsive to said request; and

displaying to said caller one or more connection options corresponding to said URL.

6. Lund does not disclose, teach, nor otherwise suggest the limitation of displaying to said caller one or more connection options corresponding to said URL. In support of rejecting claim 1 based on this limitation, the Examiner cites col. 2 line 13 of Lund:

“The microcomputer is programmed to respond to inputs from the keyboard 16 and to provide output to the display 14.”

7. To put this portion of Lund in context, the microprocessor referred to in Col. 2, line 12 is disclosed as being incorporated into a smart telephone. However, there is no disclosure in this portion of Lund that the microprocessor displays to a caller one or more *connection options corresponding to a URL returned in response to a connection request*. All this paragraph of Lund is describing is that the microprocessor

is used to connect the smart telephone to the Internet using a modem connected to the microprocessor. The claimed invention is not claiming merely a smart telephone that uses a microprocessor to connect to the Internet. Thus, this portion of Lund does not teach, disclose, nor otherwise suggest the claimed limitation of presenting to a user one or more connection options corresponding to a URL returned in response to a connection request.

8. The Examiner also cites Lund at FIG. 4 in support of rejecting this limitation of claim 1. However, FIG. 4 merely illustrates a flowchart of a sequence of the following acts: collect dialed telephone number, query database for URL, retrieve called party web page, display web page to calling party customer premises equipment (CPE). Applicant asserts that retrieving and displaying a web page is not equivalent to the limitation of displaying one or more connection options to a user. Referring the Examiner to Webster's Dictionary, the word "option," as plainly used in this limitation of claim 1, is defined as "something chosen or available as a choice." There is nothing OPTIONAL about the sequence of acts illustrated in FIG. 4 or its accompanying text (col. 3, line 27). Directing the Examiner's attention to claim 2 of the present application, claim 2 of the present invention underscores that the connection option is something that is chosen by the user (caller).

9. The Examiner cites Lund at col. 2, line 65-col. 3, line 9 as disclosing the claim limitation of displaying to the caller one ore more connection options corresponding to the returned URL. However, upon inspection of this cited portion of Lund, Applicant asserts that no such disclosure, teaching or suggestion is present in Lund. Lund at col. 2, line 65- col. 3, line 9 recites:

Preferably, these databases contain information identifying the types of services available to each CPE 100-122 and related information such as, but not limited to, FAX numbers, e-mail addresses, cellular numbers, and computer-network addresses, such as Internet location identifiers (e.g., (URLs)). The information may be stored in a memory storage device such as random access memory or a magnetic or optical disk drive, known to those skilled in the art. Of course, a combination of different memory storage devices or other types of devices may be used. The memory storage device preferably stores the service information in a data record such as an array, lookup or pointer table, or other data structures known to those skilled in the art.

10. This portion of Lund does not disclose, teach nor suggest making any sort of presentation of this information to a user. It merely describes databases containing such information. In no portion of Lund is there a description of providing a user with connections OPTIONS.

11. The Examiner indicates understanding of this by citing in the rejection under 35 U.S.C. 103(a) that Lund fails to explicitly show choosing by the caller, at least one of the connection options. This is a clear indication that providing the user with OPTIONS is not present in Lund

12. Since the prior art reference cited by the Examiner fails to disclose each and every claimed element, then the prior art reference fails to anticipate the claimed invention. In view of the foregoing, it is respectfully requested that the rejection be withdrawn and it is respectfully asserted that these claims are in condition for allowance.

13. In the Office Action mailed 9/08/04, claims 2, 3, 18-20, 24, 25, 40-42, 46, 47, 62-64, 68, 69, and 84 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lund (U.S. Patent 6,658,100) in view of Haserodt (U.S. Patent 6,031,836). Applicant respectfully traverses this rejection. In order to maintain a rejection the Examiner has the

burden of providing evidence of prima facie obviousness. See MPEP §2143. See also In Re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In order to prove prima facie obviousness, the Examiner must provide evidence in the prior art of a motivation to combine or modify a reference, a reasonable expectation of success, and a teaching of each and every claimed element. Id.

14. Applicant asserts that the Examiner has failed to make a prima facie showing of obviousness in rejecting claims 2, 3, 18-20, 24, 25, 40-42, 46, 47, 62-64, 68, 69, and 84. Claims 2, 3, and 18-20 depend from independent claim 1, claims 24, 25, and 40-42 depend from independent claim 23, claims 46, 47, and 62-64 depend from independent claim 45, claims 68 and 69 depend from independent claim 67, and claim 84 depends from independent claim 77. Independent claims 1, 23, 45, 67 and 77 contain similar limitations, as discussed above in the context of claim 1 and the Examiner's rejection under 35 U.S.C. 102(e).

15. The third requirement of an obviousness rejection under 35 USC 103(a) as explicitly stated in MPEP 2143, that the prior art references must teach or suggest all the claim limitations.

#### 16. MPEP 2143 BASIC REQUIREMENTS OF A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a prima facie case of obviousness, three basic criteria **must** be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art references must teach or suggest all the**

**claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure.**

17. Applicant traverses the 35 USC 103 rejection of claims 2, 3, 18-20, 24, 25, 40-42, 46, 47, 62-64, 68, 69, and 84 and asserts that neither Lund nor Haserodt teach every limitation of these claims. Specifically, Applicant respectfully traverses Examiner's argument that Lund anticipates every limitation of the independent claim 1 (and thus the remaining independent claims 23, 45, 67, and 77). Applicant incorporates herein the arguments presented above with respect to the 35 U.S.C. 102(e) rejections.

18. The Examiner cites Haserodt at col. 3, line 24 as disclosing the limitation of Applicant's invention of choosing the presented at least one connection options. Haserodt, at col. 3, line 24, reads:

Telephony feature server 105 also functions as a "gateway keeper", in the parlance of the ITU H.323 protocol standard, for telephony gateway 107 which is a "gateway" in the parlance of the H.323 protocol standard.

19. This cited portion of Haserodt does not describe a user choosing from presented one or more connection options. Haserodt's telephony gateway 107 is described at col. 3, line 5 as something that interconnects the Internet network 109 with telephone network 110 – **it does not describe nor otherwise suggest presenting connection options to a user or facilitate the selection by a user from the one or more connection options.**

20. The Examiner cites Haserodt at col. 3, line 59 as disclosing the limitation of Applicant's invention of choosing the presented at least one connection options.

Haserodt, at col. 3, line 59, reads:

The use that is made of page 115 by clients 101-103 to access telephony features is flowcharted in FIG. 2. To access page 115, a user of client 101 uses browser 113 to access server 104 and select page 115 in a conventional WWW manner, at step 200.

21. This portion of Haserodt merely describes the bare functionality of a smart telephone. Applicant is not claiming the bare functionality of a smart telephone. Rather, as evidenced by every independent claim in the present application, Applicant is claiming the presentation of connection options to a user in response to a user initiating a VoIP telephone call.

22. Because the Examiner has failed to support a rejection of the independent claims 1, 23, 45, 67, and 77 as required by MPEP section 2131, and uses the flawed rejection to support the rejection under 35 U.S.C. 103(a), the Examiner has failed to provide a prima facie case for obviousness as required by MPEP section 2143. Applicant respectfully asserts that the claims are in condition for allowance.

## CONCLUSION

22. Applicant has addressed all grounds for rejection and objection as stated in the Office action mailed September 8, 2004, and respectfully requests that the Examiner withdraw all rejections and place this application in condition for allowance.

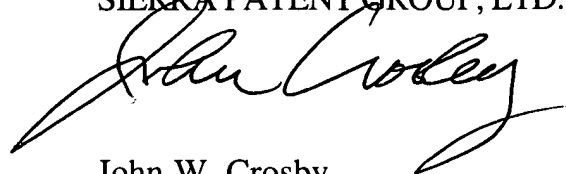
INVITATION TO TELEPHONE CONFERENCE

If any remaining issues exist, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Date: December 8, 2004

Sierra Patent Group, Ltd.  
P.O. Box 6149  
Stateline, Nevada 89449  
Telephone: (775) 586-9500

Respectfully submitted,  
SIERRA PATENT GROUP, LTD.

A handwritten signature in black ink, appearing to read "John W. Crosby", written over the printed name.

John W. Crosby  
Reg. No. 49,058